UNITED STATES PATENT AND TRADEMARK OFFICE

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10/036,849	11/08/2001	Philippe Eckert	B-4379 619291-0	4047

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EXAMINER
SCUDERI, PHILIP S

ART UNIT	PAPER NUMBER
2153	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 February 2008*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-11,13,14,16-22 and 25-32* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-11,13,14,16-22 and 25-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37

CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for

continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely

paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission has been entered.

Response to Arguments

I.   35 U.S.C. § 101

Applicant's arguments filed 10/31/2007 ("Remarks") in regards to the rejections under §101

have been fully considered but they are not fully persuasive.

1.   In the last office action the examiner took the position that the claimed web server

constituted functional descriptive material because one of ordinary skill in the art would appreciate

that a web server can be a software program.

Applicant argues that other sources such as Wikipedia define a web server as a computer

program or a computer. (Remarks, pp. 10-11). Applicant concludes that one of ordinary skill in the

art would interpret the claimed web server to be hardware, not software as alleged by the examiner.

(Remarks, pp. 11).

The examiner finds this argument unpersuasive. Applicant has stated that a web server can

be a computer program or a computer. (Remarks, pp. 11). The specification does not limit the

claimed web server to either of these embodiments. As such, the broadest reasonable definition of a

web server includes <u>both</u> a computer program (i.e., software) and a computer (i.e., hardware).

2.   Applicant argues that the system claims such as claim 1 produce a useful, concrete, and

tangible result.

The examiner finds this argument persuasive. The system claims are clearly capable of and

intended to perform the steps that they claim. These steps produce a useful, concrete, and tangible

result such as generating a response.

II.   **Prior Art**

Applicant's arguments filed 10/31/2007 ("Remarks") in regards to the prior art rejections

have been considered and they are fully persuasive.

Applicant argues that the "configured to" language has been replaced with "programmed to."

(Remarks, pp. 11-12). Applicant argues that this means that the claimed elements are limited to

performing the claimed functions. (Remarks, pp. 11-12).

The examiner finds this argument persuasive. As such, the examiner has withdrawn the

prior art rejections set forth in the last office action. However, upon further consideration, new

grounds of rejection are presented below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and
using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or
with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by
the inventor of carrying out his invention.

Claims 28-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

These claims recite the limitation "the content information and the destination <u>are</u> the body of the message" (emphasis added). The examiner interprets this the term "are" as being closed-ended, meaning the claim requires the content information and the destination information to be the <u>only</u> information in the body of the message.

The specification states that "the first client system 11 will generate message information, including destination information and content information i.e. the body of the message, and forward this message as a publish instruction." (Spec., pp. 8-9). The examiner understands the "body" referenced by the specification to refer to the "content information." Note that there is no comma or other punctuation between "content information" and "i.e. the body of the message."

The examiner interprets the specification as supporting that the body of the message can include but is not limited to (i.e., comprises) "content information." However, the examiner does not understand the specification as disclosing that the body can necessarily include "destination information."

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 4-11, 13, 14, 16-21, 25-28, and 30-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

These claims are non-statutory because they can reasonably be interpreted as software alone and therefore cover functional descriptive material claimed as descriptive material per se. (MPEP § 2106.01). For example, the adapters can be servlets and the server can be a webserver implemented as software. (Spec., pp. 7, 18).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 4, 6-11, 16, 17, 20-22, and 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Eggleston</u> (U.S. Patent No. 5,771,353), <u>RFC 788</u> (RFC 788, Simple Mail Transfer Protocol, November 1981, by Jonathan Postel), and <u>RFC 1939</u> (RFC 1939, Post Office Protocol – Version 3, May 1996, by J. Myers).

Eggleston teaches a system for retrieving email from an email post office box. A client (e.g., 201) is registered or authenticated with a server (220). (Eggleston, fig. 2, 3, col. 4, ll. 1-10). Upon successful registration or authentication, a query is generated for, e.g., all unread mail in the client's (e.g., 201) email post office box. (Eggleston, fig, 2, 3, col. 4, ll. 34-36). Any new mail is then forwarded to the client (201) via a virtual session manager (VSM). (Eggleston, fig. 2, 3, col. 63-66,

col. 4, ll. 36-38). Timers are reset after each data exchange. (Eggleston, col. 5, ll. 15-17). If no data

exchange occurs within a predetermined period of time then the server (220) forwards a logoff

message to the client via the VSM. (Eggleston, fig. 2, 3, col. 5, ll. 17-23).

Eggleston is silent in regards to (1) how new email ends up in the client's email post office

box and (2) the details of the protocol used to pull messages from the email post office box.

One of ordinary skill in the art would appreciate that the email requires an email sender and

that a computer configured to send an email was well known in the art. It would have been obvious

to one of ordinary skill in the art to use one of the clients (201, 211, 212) to send the email in order

to, inter alia, enable users to communicate.

RFC 788 describes Simple Mail Transfer Protocol (SMTP), which was a known protocol for

sending email. It would have been obvious to one of ordinary skill in the art to use SMTP here to

send the email because it was known to transfer email reliably and efficiently. (RFC 788, pp. 1).

RFC 1939 describes Version 3 of the Post Office Protocol (POP3), which was a known

protocol for retrieving email from an email post office box. It would have been obvious to one of

ordinary skill in the art to use POP3 here to retrieve the email because would be capable of

retrieving the email messages and because a person of ordinary skill has good reason to pursue the

known options within his or her technical grasp.

The prior art detailed on the preceding pages meets claim 1. The elements map in the

following manner:

Claim Element	Prior Art Element
first client system	email sender's computer (e.g., 211 or 212) (Eggleston, fig. 2)
second client system	email recipient's computer (e.g., 201) (Eggleston, fig. 2)
message comprising content information and destination information	email message sent by the sender (e.g., 211 or 212) comprising email content and a the email address of the recipient (e.g., 201) (Eggleston, fig. 2; RFC 788, pp. 6)
message channel	the recipient's (e.g., 201) email post office box (or maildrop or mailbox) (Eggleston, col. 4, ll. 34-36; RFC 1939, pp. 4)
message request comprising source information	login request by the recipient (e.g., 201) comprising the recipient's (e.g., 201) USER name or PASS string (Eggleston, col. 4, ll. 1-10; RFC 1939, pp. 4, 13-14)

The claimed "channel adapters" can reasonably be construed as any hardware or software

programmed to perform the corresponding functions. For example, the claimed "first channel

adapter" is any hardware or software programmed to perform the receiving and reading functions

recited in lines 5-8 of claim 1. The claimed "channel adapters" are inherent because the system must

be programmed to perform its functions.

As to claim 4, Eggleston teaches that server (220) generates a response encoded in a format

capable of being transmitted over the Internet (Eggleston, fig. 2, col. 2, ll. 45-51).

As to claim 6, Postel teaches an address information store wherein channel information

corresponding to at least one of the destination information and source information is stored.

(Postel, pp. 6 (emails comprise a destination address), 20 (email is delivered to a recipient's

mailbox)).

As to claims 7 and 8, the applied prior art does not expressly teach that the email system comprises another mailbox (i.e., another message channel) that the email recipient uses to send a response email to the first client system, wherein the response email comprises the original email. Responding to an email with a copy of an original email was well known in the art. As such, it would have been obvious to do so in the instant case so that the recipient could respond to the email (message) accordingly.

As to claims 9-11, the applied prior art does not expressly teach that the messages are encoded in HTTP format or that they comprise HTTP POST or GET requests. However, the messages are merely email messages. It was well known in the art to encode email content using HTTP, to thereby make email content easier to read or more attractive. It was also generally well known in the art to send POST or GET URLs in the content of emails, thereby conveniently linking users to information or websites relevant to email content.

As to claim 16, Eggleston teaches, when the response comprises a time out response, generating an output comprising re-transmitting the message request to the server (Eggleston, col. 5, ll. 23-31).

As to claim 17, Myers teaches that the response comprises a message and that response comprises a message, and the receiver module is operable to generate an output comprising the content information. (Myers, pp. 8).

As to claim 20, Eggleston teaches at least one client system. (Eggleston, fig. 2).

As to claim 21, Eggleston teaches that the server and the client can be connected via a WAN (Eggleston, fig. 2), but does not appear to state that the WAN can be the Internet. However, the Internet was a notoriously well known WAN. It would have been obvious for the client to connect to the server via the Internet so that the client could conveniently connect from various locations.

As to claim 22, the prior art combined above meets the claim. The elements map in the

following manner:

Claim Element	Prior Art Element
first client system	email sender's computer (e.g., 211 or 212) (Eggleston, fig. 2)
second client system	email recipient's computer (e.g., 201) (Eggleston, fig. 2)
message comprising content information and destination information	email message sent by the sender (e.g., 211 or 212) comprising email content and a the email address of the recipient (e.g., 201) (Eggleston, fig. 2; RFC 788, pp. 6)
message channel	the recipient's (e.g., 201) email post office box (or maildrop or mailbox) (Eggleston, col. 4, ll. 34-36; RFC 1939, pp. 4)
message request comprising source information	login request by the recipient (e.g., 201) comprising the recipient's (e.g., 201) USER name or PASS string (Eggleston, col. 4, ll. 1-10; RFC 1939, pp. 4, 13-14)
push request to place the content information in a message channel corresponding to the destination information	sending the email (e.g., by 211 or 212) to store it in the user's email box (Eggleston, col. 4, ll. 34-36)

As to claims 25-27, these claims map to the prior art in substantially the same manner as

claim 22.

As to claims 28-32, these claims require the content information (body of the email) and the

destination information (email address) to together make up the body of the message (email).

However, it was well known in the art to respond to an email with a copy of previous emails

including their destination addresses. It would have been obvious to respond to such an email here

so that the email sender and recipient could continue their conversation.

Claims 5, 13, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Eggleston (U.S. Patent No. 5,771,353), RFC 788 (RFC 788, Simple Mail Transfer

Protocol, November 1981, by Jonathan Postel), and RFC 1939 (RFC 1939, Post Office

Protocol – Version 3, May 1996, by J. Myers), and further in view of Birrell (U.S. Patent No.

6,029,164).

The RFCs describe standard email systems wherein clients access their mailboxes directly

using the post office protocol. However, it was well known in the art to provide a web server so

that clients can access their email from alternate locations, as evidenced by Birrell (figure 2). As

such, it would have been obvious to one of ordinary skill in the art to provide a such a web server

for the same reasons. It was generally well known in the art to provide firewalls for reasons such as

providing network security and would have been obvious to do so in the instant case for the same

reasons.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston

(U.S. Patent No. 5,771,353), RFC 788 (RFC 788, Simple Mail Transfer Protocol, November

1981, by Jonathan Postel), and RFC 1939 (RFC 1939, Post Office Protocol – Version 3, May

1996, by J. Myers), and further in view of Cobb (U.S. Patent No. 6,199,102).

Firewalls were generally well known in the art. In a similar art, Cobb teaches a message filter

that acts as a firewall between a recipient and a POP server (figure 2; column 6, lines 12-35). It

would have been obvious to one of ordinary skill in the art to provide such a firewall, thereby

addressing the need to filter unsolicited email (Cobb, column 2, lines 21-23).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip S. Scuderi whose telephone number is (571)272-5865. The examiner can normally be reached on Monday-Friday 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Glenton B. Burgess/
Supervisory Patent Examiner, Art Unit 2153

/P.S./